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OFFICE OF PETITIONS

Haverstock & Owens LLP
162 N. Wolfe Road
Sunnyvale, CA 94086

In re Ritu Shrivastava
Application No.: 09/315,599
Filed: May 20, 1999
Patent No.: 6,903,434
Issued: June 7, 2005

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on the June 27, 2005 petition titled "Petition For Issuance Of A Corrected Patent," which requests republication of U.S. Patent No. 6,903,434 ("the '434 patent") with corrected drawings ("the June 27, 2005 petition").

The June 27, 2005 petition is being treated as a petition under 37 CFR 1.182. A petition fee under 37 CFR 1.17(f) of \$400.00 has been charged to Deposit Account No. 08-1275, pursuant to the authorization in the Transmittal Letter accompanying the June 27, 2005 petition.

The June 27, 2005 petition is before the Office of Patent Legal Administration (OPLA) for consideration.

The June 27, 2005 petition is **dismissed**.

At page 1 of the June 27, 2005 petition, patent owner states that the '434 patent was issued with the informal drawings that accompanied the original filing of the 09/315,599 application ("the '599 application"). In the remainder of the June 27, 2005 petition, patent owner: (i) requests the Office to correct the '434 patent by issuing a corrected patent under 37 CFR 1.322(b) containing the formal drawings filed together with the June 27, 2005 petition; and (ii) explains that the formal drawings were never submitted during prosecution because the examiner never requested them.

35 U.S.C. 254 is titled "Certificate of correction ***of Patent and Trademark Office mistake***" (emphasis added) and is the sole provider of statutory authority for the Office to issue a corrected patent.¹ Notably, 35 U.S.C. 255, which is titled "Certificate of correction ***of applicant's mistake***" (emphasis added), does not mention a corrected patent.

¹ The last line of 35 U.S.C 254 states that "[t]he Director may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction."

37 CFR 1.322(b) is the regulation implementing 35 U.S.C. 254; it provides:

If the nature of the ***mistake on the part of the Office*** is such that a certificate of correction is deemed inappropriate in form, the Director may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee. [Emphasis added.]

Thus, issuance of a corrected patent under 35 U.S.C. 254 and 37 CFR 1.322(b) is reserved for those instances in which the mistake to be corrected in the patent is a mistake on the part of the Office. The Office has no statutory authority to issue a corrected patent for a mistake in a patent that was not a mistake on the part of the Office. For the reasons below, it was not a mistake on the part of the Office for the '434 patent to issue with the May 20, 1999 drawings.

The '599 application was filed May 20, 1999, and issued as the '434 patent on June 7, 2005. During the pendency of the '599 application, the Office published a notice in the January 16, 2001 issue of the *Official Gazette* advising the public of revised patent drawing procedures.² The January 16, 2001 notice states that, under the revised procedures, "most drawings will be considered acceptable (even if they are designated by applicant as 'informal')." The January 16, 2001 notice also states that "in most situations, patent application publications and patents will reflect the quality of the drawings that are included with a patent application on filing unless applicant voluntarily submits better quality drawings." The foregoing statements from the January 16, 2001 notice are essentially reproduced in MPEP 507, as of the Eighth Edition (August 2001).

In addition, MPEP 608.02(b)(I) was revised in May 2004 (Eighth Edition, Rev. 2), i.e., during the pendency of the '599 application, to provide, in pertinent part:

The Office no longer considers drawings as formal or informal. Drawings are either acceptable or not acceptable. Drawings will be accepted by the Office of Patent Application Processing (OPAP) if the drawings are readable and reproducible for publication purposes. See MPEP § 507.

In the present instance, the '434 patent was issued with the only drawings of record at the time of issuance, i.e., the drawings included with the '599 application on its May 20, 1999 filing date. Subsequent to the revision of patent drawing procedures in 2001, the Office did not object to the May 20, 1999 drawings and require corrected drawings. Indeed, as noted in the June 27, 2005 petition, the February 1, 2005 Notice of Allowability states that "[t]he drawings filed on 5/20/99 are accepted by the Examiner." Therefore, issuance of the '434 patent with the May 20, 1999 drawings was in accordance with proper Office procedure

² See: 1242 OG 114 (January 16, 2001).

For the foregoing reasons, it was not a mistake on the part of the Office for the '434 patent to issue with the May 20, 1999 drawings. Accordingly, the June 27, 2005 petition requesting republication of the '434 patent with corrected drawings is **dismissed**.

Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.



Robert A. Clarke
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy



Ifw PATENT

Attorney Docket No.: PATENT
ALSC-00300

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Group Art Unit: 2814
Ritu Shrivastava) Examiner: Ha, N.
Serial No.: 09/315,599) **TRANSMITTAL LETTER**
Filed: May 20, 1999) 162 North Wolfe Road
For: **A METHOD OF AND APPARATUS) Sunnyvale, California 94086**
FOR INTEGRATING FLASH) (408) 530-9700
EPROM AND SRAM CELLS ON A) Customer Number 28960
COMMON SUBSTRATE)

Honorable Commissioner of Patents
Washington, D.C. 20231

Sir:

Enclosed please find a petition for issuance of a corrected patent for filing with the U.S.
Patent and Trademark Office.

~~The Commissioner is authorized to charge any additional fee or credit any overpayment~~
~~to our Deposit Account No. 08-1275.~~ An originally executed duplicate of this transmittal is
enclosed for this purpose.

Respectfully submitted,
HAVERSTOCK & OWENS LLP

Dated: June 23, 2005

By: *Jonathan O. Owens*
Jonathan O. Owens
Reg. No.: 37,902

Attorneys for Applicant

CERTIFICATE OF MAILING (37 CFR 1.600)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450

HAVERSTOCK & OWENS LLP.

Date: 6-23-05 By: *Jonathan O. Owens*

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PATENT
Attorney Docket No.: ALSC-00300

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Group Art Unit: 2814
Ritu Shrivastava)	Examiner: Ha, N.
Serial No.: 09/315,599)	PETITION FOR ISSUANCE OF A
)	CORRECTED PATENT
Filed: May 20, 1999)	162 North Wolfe Road
)	Sunnyvale, CA 94086
For: A METHOD OF AND APPARATUS)	(408)530-9700
FOR INTEGRATING FLASH)	
EPROM AND SRAM CELLS ON A)	
COMMON SUBSTRATE)	

Honorable Commissioner of Patents
Washington, D.C. 20231

Sir:

Applicant hereby petitions for issuance of a corrected patent under 35 U.S.C §1.322(b) because a certificate of correction is inappropriate in form for correcting the mistakes as printed in the issued patent. In particular, in the above-referenced patent, informal drawings accompanied the original filing of the application. Along with the first Office Action, mailed September 26, 2000, the Examiner included a Notice of Draftsperson's Patent Drawing Review in which the Draftsperson objected to the drawings for several reasons under 37 C.F.R. §1.84. The Notice stated, "the Examiner will require submission of new, corrected drawings when necessary." New, corrected drawings were never requested by the Examiner, nor were they submitted by the Applicant. In fact, in the Notice of Allowability, mailed on February 1, 2005, the Examiner checked box No. 3, indicating acceptance of the drawings filed on May 20, 1999 (with the original application).

Due to this error, the Applicant never submitted formal drawings in the file and it has issued, and been published, with drawings that do not meet a number of the requirements of 37 C.F.R. §1.84. There is no doubt that the requirements of 37 C.F.R. §1.84 are intended to ensure that those seeking to understand an often-complicated invention solely through the words and images contained in a patent have every possible advantage. Without clear drawings, a patent begins to shirk one of its primary tasks: to put the public on notice of the patented invention. In this case, someone reading the patent as it has been issued might not understand the patented


invention to the extent that he or she would have if the formal drawings had been included. Because of the nature of this error, the Applicant petitions the Commissioner to issue a corrected patent under 35 U.S.C. §254 and 37 C.F.R. §1.322(b) in order that the corrected patent will be more appropriate in form than a certificate of correction accompanying the patent as it has been issued.

The Applicant has not completed a Certificate of Correction Form PTO-1050 or a Request for Certificate of Correction of Patent for PTO Mistake, instead the Applicant has attached a set of formal drawings appropriately marked for inclusion with the above-referenced patent. To completely correct the mistake, a Certificate of Correction form that is at least 12 pages in length would be necessary, thus it is the Applicant's opinion that a corrected patent should be issued; however, should the Commissioner determine that a certificate of correction is appropriate to correct this mistake, please contact the undersigned at your earliest convenience whereupon the Applicant will supply the necessary forms.

If the Commissioner or any other person responsible for correcting this patent has questions or comments concerning this petition, they are encouraged to contact the undersigned at (408) 530-9700.

Respectfully submitted,
HAVERSTOCK & OWENS LLP

Dated: June 23, 2005

By: 
Jonathan O. Owens
Reg No.: 37,902
Attorneys for Applicant

Enclosures (12 pages)

CERTIFICATE OF MAILING (37 CFR § 1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450

HAVERSTOCK & OWENS LLP.

Date: 6-23-05 By: 